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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/922,046      09/02/97      ACRES

J      4164-55

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EXAMINER

HARRISON, J

ART UNIT

PAPER NUMBER

3713

DATE MAILED:

04/25/00

04/25/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/922,046

Applicant(s)

Acres et al.

Examiner

J. Harrison

Group Art Unit

3713



☒ Responsive to communication(s) filed on ids of Dec. 17, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 62-106 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 62-106 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 14, 16-1.

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3713

## DETAILED ACTION

### *Continued Prosecution Application*

The request filed on June 24, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/922046 is acceptable and a CPA has been established. An action on the CPA follows.

Claims 62 - 106 are pending in the instant application.

Acknowledgment is made of Applicant's IDS statements of June 24, 1999, August 27, 1999, November 18, 1999 and December 17, 1999.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3713

Claims 62 - 106 are rejected under the judicially created doctrine of double patenting over claims 1 and 10, at least, of U. S. Patent No. 5,752,882 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Both patent and application claims relate to a system/method of operating gaming devices including associating each game device with a unique address, (pre)selecting less than all devices, and providing a bonus to the selected devices.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 77-87, 62-67 and 100-106 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3713

Claim 77 recites paying "to the device" which is inapt. Paying to the player is suggested as this more correctly describes the action. Claims 78-87 inherit the confusion by dependency.

In claims 62 and 100, a controller is referenced. Numerous controllers are disclosed in the system. Applicant should either modify the claim to be more specific as to which controller is being claimed, or speak to the question on the record.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 68 - 76 are rejected under 35 U.S.C. 102(e or b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Piechowiak et al (Piech) or Frankovic et al (Frank) respectively.

The patent to Piech teaches a system/method of interconnected game machines which have a feature controller for providing bonus features to game machines. Note the teaching at the end of col 1 "only selected ones of the gaming machines are temporarily provided with a certain feature, where the feature is enabled based on the occurrence of some event". The step of

Art Unit: 3713

establishing is met by the playing of Piech game. The machines are polled for the detection of wagers, and bonus periods are initiated upon a predetermined event and made available to the games being played. Inherently the Piech system possesses the claimed limitations. Alternatively, in looking to implement Piech, one of ordinary skill in the art would readily appreciate the allocation of part of the wagers to the bonus pools, in order to provide funding for the pools without altering the odds of the machines or the house percentages. Similarly, it would have been obvious to one of ordinary skill in the art implementing the Piech system to further define the predetermined minimum level (such as max coin play) in order to provide the bonus system only to the players risking the maximum amount, in order to encourage that type of play.

A similar analysis can be made with the Frank system. In Frank, a random number is determined. Each machine on the system, when a coin is played, sends its identification and a number to the controller. When the number matches, the machine is rewarded with a bonus payout. Interpretation of Frank with respect to the instant claims follows the interpretation of Piech above.

***Allowable Subject Matter***

Claims 88-99 contain allowable subject matter, and would be allowed pending resolution of the rejection under double patenting.

Claims 62, 77 and 100, and those claims dependent thereon would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth

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Art Unit: 3713

in this Office action and would be allowed pending resolution of the rejection under double patenting.

***Information Disclosure Statement***

Voluminous information has been submitted to the examiner during prosecution of this application. The instant examiner, new to prosecution of this application, has thoroughly considered all information presented in the file. While individual comment upon each piece of information submitted would be exhaustive and in many instances redundant, the following general comments are made regarding the submitted information.

A substantial portion of the IDS submissions relate to allegations of disclosure of (SB-2) or offers for sale of the instant claimed invention prior to the critical date of the application, which is October 12, 1993. Under the standards promulgated in MPEP section 2133.03(b), and the guidance set forth by *Phaff v. Wells*, 48 USPQ2d 1641, the evidence must clearly show the inventor had an "invention" to offer; in particular if the invention is ready for patenting by such activity as the inventor having prepared drawings or other descriptions of invention that were sufficiently specific to enable persons skilled in the art to practice the invention. It is noted that all of the claims in the instant application include the bonusing feature of the inventive system. In the few pieces of evidence where this aspect is discussed, the level of detail does not rise to such that would establish that the invention was ready for patenting. In short, none of the evidence is sufficient to enable a person skilled in the art to practice the invention. The brochures and

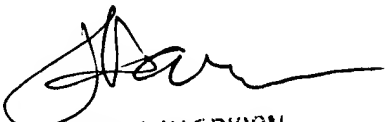
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Art Unit: 3713

publications presented merely set forth an overview of the conceptual ideas of features the system could include. No guidance is seen for actual practice of the invention as is set forth in the instant disclosure. Furthermore, in the limited instances where an alleged offer of the bonusing system in presented, it is noted that a bona fide effort to perfect the invention or to ascertain whether it will answer its intended purpose is permissible activity in the eyes of the law. The evidence suggests such was the inventors intended purpose.

Due to the new grounds of rejection presented herein, this action is not made final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Harrison whose telephone number is (703) 308-2217.

  
JESSICA J. HARRISON  
PRIMARY EXAMINER

jjh

April 24, 2000

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